

### **REMARKS**

This response is intended as a full and complete response to the non-final Office Action mailed December 31, 2003. In the Office Action, the Examiner notes that claims 1-22 are pending, of which claims 1-22 stand rejected. By this response, claims 1, 3-7, 14-15, 21, and 22 have been amended, claims 8-13 and 16-20 continue unamended, and claim 2 has been canceled.

In view of the following discussion, the applicants submit that none of the claims now pending in the application are anticipated or obvious under the provisions of 35 U.S.C. §§102 or 103. Thus, the applicants believe that all these claims are now in allowable form.

It is to be understood that the applicants, by amending the claims, do not acquiesce to the Examiner's characterizations of the art of record or to applicants' subject matter recited in the pending claims. Further, applicants are not acquiescing to the Examiner's statements as to the applicability of the prior art of record to the pending claims by filing the instant responsive amendments.

### **OBJECTIONS**

#### **THE SPECIFICATION & DRAWINGS**

The Examiner has objected to the disclosure because of the following informalities: "page 6, line 32 should read encoders 130<sub>1</sub>, 130<sub>2</sub>, and 130<sub>n</sub> rather than 1301, 1302 and 130n. Page 15, line 4 should read 'returned to the (510)' ... rather than 'returned to the (610).'"

The Examiner also objected to the drawings as failing to comply with 37 C.F.R. 1.84(p)(5) because (1) they include reference signs not mentioned in the description, and (2) they do not include reference signs mentioned in the description. Furthermore, the Examiner has objected to the disclosure for various irregularities.

In response to those issues the applicants have (1) amended the specification to add some missing reference signs, and have amended the drawings to delete some reference signs. In particular:

Elements 728, 730, 736, 738, and 1902 are added to the specification, and Figure 5B is amended to delete elements 530, 531, 532 and 533.

In view of the foregoing amendments, Applicants respectfully request withdrawal of all objections and rejections of the specification and drawings.

### **THE CLAIMS**

The Examiner has objected to claim 22 for lacking antecedent basis for "the transport multiplexer" in line 8. As suggested by the Examiner and as treated in the action, "the transport multiplexer" in line 8 should have read "the transport demultiplexer," and applicants have amended claim 22 to correct the obvious typographical error. Therefore, applicants respectfully request that the Examiner's objection be withdrawn.

### **REJECTIONS**

#### **35 U.S.C. §102**

##### **Claims 1 and 8-13**

The Examiner has rejected claims 1 and 8-13 under 35 U.S.C. §102(e) as being anticipated by Lawler et al. (5,805,763, hereinafter "Lawler"). In view of the above amendment to claim 1, the independent claim upon which claims 8-13 depend, the Applicants respectfully traverse the rejection.

Applicants' independent claim 1 recites:

"A method for providing a custom interactive program guide (custom-IPG), the method comprising:  
receiving selections indicative of a set of channels to be included in the custom-IPG;  
rendering one or more custom-IPG screens, at a head end, having included therein the set of selected channels;  
receiving a request to view a custom-IPG screen on a particular channel;  
overlaying the custom-IPG screen on a video sequence being provided on the particular channel to generate a modified video sequence having included therein the custom-IPG; and  
providing the modified video sequence on the particular channel from the head end." [Emphasis added]

At least for the above-emphasized reasons claim 1 is allowable. "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim" (*Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984)(citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)).

Lawler teaches an interactive recording system that enables a user to select a program for recording from a program guide. In response to a user selection, the Lawler system sets a "record tag" that identifies the selected program to be recorded. The record tag is monitored and, at the appropriate time, prompts the system to control the recording of the program. Such controlled recording either can be at the user site or at the head end.

The Lawler reference fails to disclose each and every element of the claimed invention, as arranged in the claim. In particular, Lawler does not teach or suggest receiving a request for a custom-IPG screen on a particular channel. Furthermore, Lawler does not teach providing a modified video sequence on the particular channel from the head end. Therefore, each and every element of the claimed invention, arranged as in claim 1, is not taught or even suggested by the Lawler reference.

As such, the Applicants submit that independent claim 1 is not anticipated under 35 U.S.C. §102 and is fully patentable thereunder. Furthermore, claims 8-13 depend, either directly or indirectly, from independent claim 1 and recite additional limitations thereof. As such and for at least the same reasons, the Applicants submit that these dependent claims are not anticipated under 35 U.S.C. §102 and are fully patentable thereunder. Therefore, the Applicants respectfully request that the rejections of claims 1 and 8-13 be withdrawn.

#### **Claims 1 and 9-13**

The Examiner rejected claims 1 and 9-13 under 35 U.S.C. §102(e) as being clearly anticipated by Boyer et al. (2003/0066085, hereinafter "Boyer"). Applicants respectfully traverse the rejection.

The foregoing comments with regard to claim 1 also apply to the rejections of claims 1 and 9-13 being anticipated by Boyer.

The Boyer reference fails to disclose each and every element of the claimed invention, as arranged in the claim. In particular, Boyer does not teach or suggest receiving a request for a custom-IPG screen on a particular channel. Furthermore, Boyer does not teach providing a modified video sequence on the particular channel from the head end. Therefore, each and every element of the claimed invention, arranged as in claim 1, is not taught or suggested by the Boyer reference.

As such, the Applicants submit that independent claim 1 is not anticipated under 35 U.S.C. §102 and is fully patentable thereunder. Furthermore, claims 9-13 depend, either directly or indirectly, from independent claim 1 and recite additional limitations thereof. As such and for at least the same reasons, the Applicants submit that these dependent claims are not anticipated under 35 U.S.C. §102 and are fully patentable thereunder. Therefore, the Applicants respectfully request that the rejections of claims 1 and 9-13 be withdrawn.

### **35 U.S.C. §103**

#### **Claims 2-7**

The Examiner has rejected claims 2-7 under 35 U.S.C. §103(a) as being unpatentable over Lawler in view of Lemmons (6,442,755, hereinafter "Lemmons"). Applicants respectfully traverse the rejection.

Applicants note that claim 2 has been cancelled in view of the amendment to claim 1. Furthermore, the claim dependencies of claims 3-7 have been corrected in view of the cancellation of claim 2. Because of the amendment to claim 1, the Applicants will consider the 35 U.S.C. §103(a) rejection as being directed to claims 1 and 3-7.

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 U.S.P.Q. 1021, 1024 (Fed. Cir. 1984) (emphasis added). Thus, it is impermissible

to focus either on the “gist” or “core” of the invention, Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 230 U.S.P.Q. 416, 420 (Fed. Cir. 1986). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 U.S.P.Q. 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added).

Applicants assert that neither Lawler nor Lemmons, either singly or in combination, teach the Applicants' invention as a whole.

As discussed above, Lawler discloses an interactive recording system that enables a user to select a program for recording from a program guide. In response to a user selection, the system sets a “record tag” that identifies the selected program to be recorded. The record tag is monitored and, at the appropriate time, prompts the system to control the recording of the program. Such controlled recording either can be at the user site or at the head end.

The Lawler reference fails to disclose each and every element of the claimed invention, as arranged in the claims. In particular, Lawler does not teach or suggest receiving a request for a custom-IPG screen on a particular channel. Furthermore, Lawler does not teach providing a modified video sequence (which includes the custom-IPG screen) on the particular channel from the head end. Therefore, Lawler fails to teach or suggest the applicants' invention as a whole.

Furthermore, Lemmons fails to bridge the substantial gap as between Lawler and the Applicants' invention. Specifically, Lemmons discloses an interactive television program guide having elements that are arranged and styled using markup language documents. The program guide interprets the markup language documents and generates the display screens and program guide functionality without user intervention. The program guide may also be updated by supplying new markup language documents that modify display screens and program guide functionality. The markup language documents may be supplied by a main facility or a television distribution facility.

However, nowhere in Lemmons is there any teaching or suggestion of receiving a request for a custom-IPG screen on a particular channel. Furthermore, Lemmons

does not teach providing a modified video sequence (which includes the custom-IPG screen) on the particular channel from the head end.

Therefore, even if the two references could somehow be operably combined, the combination would still not provide a modified video sequence (which includes the custom-IPG screen) on a requested channel from the head end. Therefore the combined references fail to teach or suggest applicants' invention as a whole.

As such, the applicants submit that claim 1 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Furthermore, claims 3-7, which depend from claim 1 and recite similar features thereof. As such, and for at least the same reasons as discussed above, the applicants submit that claims 3-7 are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the applicants respectfully request that the rejections be withdrawn.

#### **Claims 14-20**

The Examiner has rejected claims 14-20 under 35 U.S.C. §103(a) as being unpatentable over Lawler in view of Eyer (5,982,445, hereinafter "Eyer '445"). Applicants respectfully traverse the rejection.

Applicants' independent claim 14, as amended recites:

"A method for creating a custom interactive program guide (custom-IPG), the method comprising:

activating a program guide customization process;

receiving a pop-up menu provided to assist in the customization process;

selecting a channel on which to receive the custom-IPG;

selecting a set of channels to be included in the custom-IPG; and

receiving on the selected channel a custom-IPG screen having included therein the set of selected channels, wherein the custom-IPG screen is rendered at a head end."

Neither Lawler nor Eyer '445, either singly or in combination, teaches the applicants' invention as a whole.

As discussed above, Lawler discloses an interactive recording system that enables a user to select a program for recording from a program guide. In response to a user selection, the system sets a "record tag" that identifies the selected program to be recorded. The record tag is monitored and, at the appropriate time, prompts the system to control the recording of the program. Such controlled recording either can be at the user site or at the head end.

The Lawler reference fails to disclose each and every element of the claimed invention, as arranged in the claims. In particular, Lawler does not teach or suggest selecting a channel on which to receive a custom-IPG and then receiving that custom-IPG screen on the selected channel, wherein the custom-IPG screen is rendered at a head end.

Furthermore, Eyer fails to bridge the substantial gap as between Lawler and the applicants' invention. Specifically, Eyer '445 discloses an Interactive Program Guide (IPG) data that is delivered to integrated receiver-decoders (IRDs) via, for example, satellite. The IPG data provides scheduling information for global and local programming services. Each IRD is assigned to an IPG region, and IPG data is filtered so that only the global data and the region-specific data for the IRD's IPG region is retained and processed by the IRD. Channel map data is also delivered to the IRDs so that bundles of IRD data can be filtered to discard program sources that are not present in the channel map. The IRD data which is retained after filtering is used to provide scheduling information via an on-screen display.

However, nowhere in Eyer '445 is there any teaching or suggestion of selecting a channel on which to receive the custom-IPG and then receiving a custom-IPG screen on the selected channel, wherein the custom-IPG screen is rendered at a head end. Thus, even if the two references could somehow be operably combined the combination would still not provide for selecting a channel on which to receive a custom-IPG and then receiving that custom-IPG screen on the selected channel, wherein the custom-IPG screen is rendered at a head end.

The combined references fail to embrace the problems that the Applicants' invention solves. Therefore, the combination of Lawler and Eyer '445 fails to teach or suggest the applicants' invention as a whole.

As such, the applicants submit that independent claim 14 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Furthermore, claims 15-18 depend from claim 14 and recite similar features thereof. As such, and for at least the same reasons as discussed above, the applicants submit that claims 15-18 are also not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the applicants respectfully request that the rejections be withdrawn.

#### **Claim 21**

The Examiner has rejected claim 21 under 35 U.S.C. 103(a) as being unpatentable over Eyer (6,160,545, hereinafter "Eyer '545") in view of Lawler.

Applicants' independent claim 21 recites:

"A system for providing a custom interactive program guide (custom-IPG), comprising:

a video session manager operative to receive selections indicative of a set of channels to be included in the custom-IPG and to receive a selected channel on which to receive the custom-IPG;

at least one video encoder operatively coupled to the video session manager and configured to render and encode one or more custom-IPG screens having included therein the set of selected channels;

a transport multiplexer coupled to the video encoder and operative to receive the one or more encoded custom-IPG screens and generate a transport stream; and

a modulator coupled to the transport multiplexer and operative to receive the transport stream and generate an output signal suitable for transmission on the selected channel, and

wherein the one or more custom-IPG screens are provided on the output signal upon receiving a request for the custom-IPG. " [Emphasis added]

Neither Eyer '545 nor Lawler, either singly or in combination, teaches the applicants' invention as a whole.



As discussed above, Lawler discloses an interactive recording system that enables a user to select a program for recording from a program guide. In response to a user selection, the system sets a "record tag" that identifies the selected program to be recorded. The record tag is monitored and, at the appropriate time, prompts the system to control the recording of the program. Such controlled recording either can be at the user site or at the head end.

The Lawler reference fails to disclose each and every element of the claimed invention, as arranged in the claims. In particular, Lawler does not teach or suggest a video session manager operative to receive a selected channel on which to receive a custom-IPG, or a modulator that generates an output signal suitable for transmission on the selected channel.

Eyer fails to bridge the substantial gap as between Lawler and the applicants' invention. Specifically, Eyer '445 discloses an Interactive Program Guide (IPG) data that is delivered to integrated receiver-decoders (IRDs) via, for example, satellite. The IPG data provides scheduling information for global and local programming services. Each IRD is assigned to an IPG region, and IPG data is filtered so that only the global data and the region-specific data for the IRD's IPG region is retained and processed by the IRD. Channel map data is also delivered to the IRDs so that bundles of IRD data can be filtered to discard program sources that are not present in the channel map. The IRD data which is retained after filtering is used to provide scheduling information via an on-screen display.

Nowhere in Eyer '545 is there any teaching or suggestion of a video session manager that is operative to receive a selected channel on which to receive a custom-IPG, or a modulator that generates an output signal suitable for transmission on the selected channel.

The combined references fail to embrace the problems that the Applicants' invention solves. Therefore, the combination of Lawler and Eyer '445 fails to teach or suggest the applicants' invention as a whole. As such, the Applicants submit that independent claim 21 is not obvious and fully satisfies the requirements of 35 U.S.C.

§103 and is patentable thereunder. Therefore, the applicants respectfully request that the rejections be withdrawn.

**Claim 22**

The Examiner has rejected claim 22 under 35 U.S.C. 103(a) as being unpatentable over Shiga (6,005,562, hereinafter "Shiga") in view of Lawler.

Applicants' independent claim 22 recites:

"A set top terminal (STT) for providing a custom interactive program guide (custom-IPG), comprising  
a demodulator operative to receive a modulated signal and generate a transport stream;  
a transport de-multiplexer coupled to the demodulator and operative to receive and process the transport stream to provide one or more encoded custom-IPG screens on a selected channel; and  
at least one video decoder coupled to the transport de-multiplexer and operative to receive and decode the one or more encoded custom-IPG screens to provide an output video sequence, and  
wherein the one or more custom-IPG screens are rendered at a head end and sent to the STT on the selected channel upon receiving a request for the custom-IPG."

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Neither Shiga nor Lawler, either singly or in combination, teach the applicants' invention as a whole.

As discussed above, Lawler discloses an interactive recording system that enables a user to select a program for recording from a program guide. In response to a user selection, the system sets a "record tag" that identifies the selected program to be recorded. The record tag is monitored and, at the appropriate time, prompts the system to control the recording of the program. Such controlled recording either can be at the user site or at the head end.

Shiga discloses transmitting and receiving an electronic program guide that identifies programs that are to be transmitted. The Electronic program guide (EPG) includes reduced size image data that identifies programs that are to be (or are being) transmitted. The EPG data is sent with program data that represents the different programs transmitted on different broadcast channels. On reception, the EPG data is

separated from the program data. When desired, the reduced size images are displayed in superposition over a received program.

Nowhere in Shiga is there any teaching or suggestion of a transport demultiplexer that provide one or more encoded custom-IPG screens on a selected channel, or a video decoder that decodes one or more encoded custom-IPG screens to provide an output video sequence. In Shiga, the electronic program guide is sent with current program data.

The combined references fail to embrace the problems that the Applicants' invention solves. Therefore, the combination of Lawler and Shiga fails to teach or suggest the applicants' invention as a whole.

As such, the Applicants submit that independent claim 22 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Therefore, the applicants respectfully request that the rejections be withdrawn.

Conclusion

Thus, the applicants submit that claims 1-22 are in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone John M. Kelly or Eamon J. Wall, Esq. at (732) 530-9404 so appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

3/31/04

E J Wall

EAMON J. WALL, Attorney  
Reg. No. 39,414  
(732) 530-9404

Moser, Patterson & Sheridan, LLP  
Attorneys at Law  
595 Shrewsbury Avenue, Suite 100  
Shrewsbury, New Jersey 07702